

## **REMARKS**

**[0001]** Applicant respectfully requests entry of the following remarks and reconsideration of the subject application. Applicant respectfully requests entry of the amendments herein. The remarks and amendments should be entered under 37 CFR. § 1.116 as they place the application in better form for appeal, or for resolution on the merits.

**[0002]** Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claim amendment summary:

### **Claims pending**

- Before this Amendment: Claims 1-33.
- After this Amendment: Claims 1, 4-23, 25-27, 29, 30, and 33-38

**Canceled claims:** 2, 3, 24, 28, 31, and 32

**Amended claims:** 1, 4, 7-9, 14-16, 18-21, 27, 29, 30, and 33

**New claims:** 34-38

### **Claim Amendments and Additions**

**[0003]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 4, 7-9, 14-16, 18-21, 27, 29, 30, and 33 herein. Applicant amends claims to highlight particular features. Such amendments are made to expedite prosecution and to more quickly identify allowable subject matter. Such amendments are merely intended to highlight the claimed features

and improve readability of the claims, and should not be construed as further limiting the claimed invention in response to the cited references.

**[0004]** Furthermore, Applicant adds new claims 34-38 herein. These new claims are fully supported by the Application and therefore do not constitute new matter. Support for new claim 34 may be found in the specification, at least at page 13, lines 6-9. Support for new claims 35-37 may be found in the specification, at least at page 26, lines 12-16. Support for new claim 38 may be found in the specification, at least at page 12, line 25 – page 13, line 5.

## Substantive Matters

### Claim Rejections under § 102 and § 103

**[0005]** Claims 1-33 are rejected under 35 U.S.C. § 102 and § 103. The Examiner's rejections are based upon the following references alone and in combination:

- **Novak:** *Novak, et al.*, US Patent Publication No. 2003/0126599 (Published July 3, 2003);
- **Vallone:** *Vallone, et al.*, US Patent No. 6,642,939 (issued November 4, 2003);
- **Lu:** *Lu, et al.*, US Patent No. 6,647,548 (issued November 11, 2003);
- **Griecewic:** *Griecewic*, US Patent No. 6,320,591 (issued November 20, 2001); and
- **Bedard:** *Bedard*, US Patent No. 5,805,235 (issued September 8, 1998).

## **Anticipation Rejections**

### **Based upon Novak**

**[0006]** Claims 1-6, 10, 11, 14-19, and 21-33 stand rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Novak. Applicant respectfully traverses this rejection. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

### **Independent Claim 1**

**[0007]** Claim 1 is amended herein, rendering the rejection of claim 1 moot. Furthermore, Applicant submits that Novak does not anticipate this claim because it does not disclose the following elements as recited in this claim, as amended (with emphasis added):

A method for presenting information, the method comprising:  
presenting the information via a first processing mechanism;  
while presenting the information via the first processing mechanism, receiving a user-submitted command;  
in response to the user-submitted command, adding a mark that is associated with the information, via a marking mechanism of the first processing mechanism;  
transferring the information from the first processing mechanism to a second processing mechanism, the second processing mechanism being physically distinct from the first processing mechanism; and

presenting the information via the second processing mechanism based on the mark added via the first processing mechanism,

wherein at least one of said adding the mark and said presenting the information via the second processing mechanism comprises displaying a visual indicator of the mark at a display position that is related to a time at which the mark was associated with the information.

**[0008]** Novak does not disclose the claimed, “transferring the information from the first processing mechanism to a second processing mechanism, the second processing mechanism being physically distinct from the first processing mechanism.” In fact, Novak teaches against such a transfer. Specifically, in paragraph [0006]-[0008], Novak indicates that transferring media content is not desirable. In paragraphs [0027] and [0028], Novak states:

The generated bookmarks may be transmitted from the editing device to one or more playback devices via a network...

The playback device then accesses a copy of the media program...

**[0009]** Because Novak does not disclose, “transferring the information from the first processing mechanism to a second processing mechanism,” Novak does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims 2-6, 10, 11, 14-19, 21-26

**[0010]** Claims 2, 3, and 24 are canceled herein, rendering the rejection of these claims moot.

**[0011]** Claims 4-6, 10, 11, 14-19, 21-23, 25, and 26 ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 27

**[0012]** Claim 27 is amended herein, rendering the rejection of claim 27 moot. Furthermore, Applicant submits that Novak does not anticipate this claim because it does not disclose the following elements as recited in this claim, as amended (with emphasis added):

A method for presenting information, comprising:  
receiving instructions generated in response to the activation of a  
marking mechanism during the display of a first program;  
displaying a mark panel display in response to the instructions,  
wherein the mark panel display comprises:  
a selectable command to create a mark associated with the  
first program; and  
a representation of a second program, wherein:

the second program is different from the first program; and

the second program has an associated mark;  
receiving a user's input via the mark panel display; and  
in response to the user's input:

in an event that the user's input corresponds to the selectable command to create a mark associated with the first program, creating a new mark in the first program; and

in an event that the user's input corresponds to the representation of the second program, invoking the mark associated with the second program.

**[0013]** Novak does not disclose the claimed, "displaying a mark panel display...wherein the mark panel display comprises: a selectable command to create a mark associated with the first program; and a representation of a second program..."

**[0014]** In rejecting claim 27, the Examiner cites Figure 5, item 516 of Novak as illustrating a mark panel display. In paragraph [0074] Novak references Figure 5, stating that, "the editing device 402 allows a user to designate one or more points of interest within the media program." In paragraph [0076] Novak indicates that reference number 516 refers to "an on-screen status bar, which is a graphical representation of the media program."

**[0015]** Novak does not disclose a display that enables a user to either add a mark to a first program, or invoke a mark that is already associated with a second program. The display shown and described in Novak only enables a user to create marks within a single program.

**[0016]** The Examiner states, on page 11 of the Office Action:

Although Novak does not specifically mention that his system invokes a preexisting mark in a second program, his system does have the capability to be programmed to do so.

**[0017]** The Examiner's statement that Novak's system, "has the capability to be programmed to do so," is not sufficient for a rejection of the claim under section 102. Because Novak does not disclose, "displaying a mark panel display...wherein the mark panel display comprises: a selectable command to create a mark associated with the first program; and a representation of a second program... and in an event that the user's input corresponds to the representation of the second program, invoking the mark associated with the second program," Novak does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*Dependent Claims 28 and 29*

**[0018]** Claim 28 is canceled herein, rendering the rejection of this claim moot.

**[0019]** Claim 29 depends upon independent claim 27. As discussed above, claim 27 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.



Independent Claim 30

**[0020]** Claim 30 is amended herein, rendering the rejection of claim 30 moot. Furthermore, Applicant submits that Novak does not anticipate this claim because it does not disclose the following elements as recited in this claim, as amended (with emphasis added):

A system comprising:

a first processing mechanism, the first processing mechanism comprising:

a first memory;

a first processor;

presentation logic, stored in the first memory and executed by the first processor to present information;

marking logic, stored in the first memory and executed by the first processor to create a mark associated with information currently being presented, **wherein the mark is embedded in the information**; and

a second processing mechanism, physically distinct from the first processing mechanism, the second processing mechanism comprising:

a second memory;

a second processor;

communication logic, stored in the second memory and executed by the second processor to receive the information with the embedded mark;

presentation logic, stored in the second memory and executed by the second processor to present the information based

on the mark created by the marking logic of the first processing mechanism.

**[0021]** Novak does not disclose the claimed, “wherein the mark is embedded in the information.” Furthermore, Novak does not disclose the claimed, “receive the information with the embedded mark.” As discussed above with reference to claim 1, Novak specifically describes storing bookmarks separate from the media content, and the playback device accessing a copy of the media content separate from the bookmarks.

**[0022]** Consequently, Novak does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

#### *Dependent Claims 31 and 32*

**[0023]** Claims 31 and 32 are canceled herein, rendering the rejection of these claims moot.

#### *Independent Claim 33*

**[0024]** Claim 33 is amended herein, rendering the rejection of claim 33 moot. Furthermore, Applicant submits that Novak does not anticipate this claim, as amended. Claim 33 is amended herein to recite elements similar to those recited in claim 27, as

amended herein. Accordingly, Applicant submits that claim 33 is allowable over Novak for reasons similar to those given above with reference to claim 27.

**[0025]** Consequently, Novak does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

## **Obviousness Rejections**

### **Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)**

**[0026]** Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

### **Based upon Novak and Vallone**

**[0027]** Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Novak in view of Vallone. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims. Claims 7 and 8 ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

### **Based upon Novak and Lu**

**[0028]** Claim 9 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Novak in view of Lu. Applicant respectfully traverses the rejection of this claim and asks the Examiner to withdraw the rejection of this claim. Claim 9 depends upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

**Based upon Novak and Griecewic**

**[0029]** Claim 12 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Novak in view of Griecewic. Applicant respectfully traverses the rejection of this claim and asks the Examiner to withdraw the rejection of this claim. Claim 12 ultimately depends upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

**Based upon Novak and Griecewic**

**[0030]** Claim 12 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Novak in view of Griecewic. Applicant respectfully traverses the rejection of this claim and asks the Examiner to withdraw the rejection of this claim. Claim 12 ultimately depends upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

**Based upon Novak and Bedard**

**[0031]** Claims 13 and 20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Novak in view of Bedard. Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims. Claims 13 and 20 ultimately depend upon independent claim 1. As discussed

above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable.

### **Conclusion**

**[0032]** All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC  
Representatives for Applicant

/Kayla D. Brant #46,576/  
Kayla D. Brant (kayla@leehayes.com; x4742)  
Registration No. 46,576  
Customer No. **22801**

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Telephone: (509) 324-9256  
Facsimile: (509) 323-8979  
www.leehayes.com